

FILE COPY

U.S. - Supreme Court, U. S.

FILED

JAN 30 1948

CHARLES ELMORE GROPLEY
CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1947.

No. 558

GENERAL MOTORS CORPORATION,

Petitioner,

vs.

ELMER G. KESLING,

Respondent.

**PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE EIGHTH CIRCUIT AND BRIEF IN SUP-
PORT THEREOF.**

HORACE DAWSON,

CASPER W. OOMS,

Attorneys for Petitioner.

EDWIN S. BOOTH,

JOSEPH J. GRAVELY,

Of Counsel.

Because of the Indefiniteness of the Claims the Courts Below Were Able to Ascribe to the Kesling Patent a Scope Capable of Embracing Every Shifter Mechanism Using Power and Capable of Producing a Function Called "Feel", Regardless of the Construction of the Mechanism or the Manner in Which It Functions to Produce "Feel", Though "Feel" Is Not Mentioned in the Patent or Argument Before the Patent Office	20
Brief in Support of Petition for a Writ of Certiorari..	23
Patent Claims, Unlike Ordinary Contractual Instruments, Are Negotiated Without the Participation of Those Affected by Them, and to Insure That the Claims "Are Kept Within Their Legitimate Scope" It Is Imperative That the Claims Scrupulously Comply With All Representations Made to the Patent Office.....	29
A Patent Claim, Unlike Other Contractual Instruments, May Not Have Its Ambiguities Resolved by a Reconstruction to Meet the Needs of Each Suit in Which It Is Asserted, But Must Satisfy the Statutory Demand That It "Distinctly Claim" the Invention.....	29
Conclusion	36

TABLE OF AUTHORITIES CITED.

American Laundry Mach. Co. v. Strike, 103 F. (2d) 453, 456-457	26
Denominational Env. Co. v. Duplex, 80 F. (2d) 186, 192	26
Exhibit Supply Co. v. Ace Patents Corp., 315 U. S. 125.	24
General Electric v. Wabash, 304 U. S. 364, 369.....	34
Gottschalk Mfg. Co. v. Springfield, 74 F. (2d) 583, 587.4, 27	
Halliburton v. Walker, 329 U. S. 1, 8, 9, 12, 13.....	
	3, 4, 6, 20, 30, 33
I. T. S. Rubber v. Essex Rubber Co., 272 U. S. 429, 437, 438, 440, 441, 442.....	24
Keystone Driller Co. v. Northwest, 294 U. S. 42, 48....	27
Ladd v. Walker, 7 F. (2d) 72, 76.....	4, 27
Mackay Radio v. Radio Corporation of America, 306 U. S. 86, 101.....	24
Mid-Continent Inv. Co. v. Mercoind, 320 U. S. 661.....	23
Outline of Patent Law, Stringham, 1937, Page 326....	25
Parks v. Booth, 102 U. S. 96.....	31
Permutit Co. v. Graver Corp., 284 U. S. 51, 57-58.....	4, 35
Precision Instrument Mfg. Co. v. Automatic, 324 U. S. 806, 816	5, 24
Sager v. Glove Corp., 118 F. (2d) 873, 874.....	4, 28
Smith v. Mid-Continent Investment Co., 106 F. (2d) 622, 627	6, 26
Spalding v. John Wanamaker, 256 F. 530, 533-534....	25
John E. Thropp's Sons Co. v. Seiberling, 264 U. S. 320, 326-327	30
Warren Bros. v. Thompson, 293 F. 745, 747.....	26
Wiegand et al. v. Bingham Co., 106 F. (2d) 546, 548...4, 27	

STATUTE CITED.

Revised Statutes, Sec. 4888 (Title 35, U. S. Code, Sec. 33)	3, 29, 30, 35
---	---------------



IN THE
Supreme Court of the United States

OCTOBER TERM, 1947.

No. _____

GENERAL MOTORS CORPORATION,
Petitioner,

vs.

ELMER G. KESLING,
Respondent.

PETITION FOR A WRIT OF CERTIORARI.

*To the Honorable, the Chief Justice and Associate Justices
of the Supreme Court of the United States:*

Your Petitioner, General Motors Corporation, respectfully prays for a writ of certiorari to the United States Circuit Court of Appeals for the Eighth Circuit to review the judgment entered by that Court, December 17, 1947 (R. 694-695) affirming the judgment of the District Court adjudging Petitioner guilty of infringement of claims 25 to 29 inclusive of United States Letters Patent No. 2,034,400, issued to Respondent, Elmer G. Kesling on March 17, 1936 (R. S35-646).

Jurisdiction.

The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code as amended by the Act of February 13, 1925 (Title 28, U. S. Code, Sec. 347(a)).

The judgment of the Circuit Court of Appeals was entered December 17, 1947 (R. 694).

Opinion Below.

The opinion of the Circuit Court of Appeals appears in the Record at pages 671 to 694, inclusive, reported at 76 U.S.P.Q. 30.

The District Court rendered no opinion but entered Findings of Fact, Conclusions of Law and a Judgment, (R. 635-646) also reported at 66 F. Supp. 1 and 70 U.S.P.Q. 485.

Questions Presented.

1. Under the decision of this Court in *Halliburton v. Walker*,* 329 U. S. 1, do the claims of a patent satisfy the Patent Act (R.S. 4888; Title 35, U. S. Code, Sec. 33) when the novel element or "heart" of the combination claims is expressed in a general term (**actuator**) which appears nowhere in the patent specification and is defined only by the patent applicant's representations in argument to the Patent Office, and "no one of the claims has even suggested the physical structure of the" **actuator** and "no one of these claims describes the manner in which the (**actuator**) will operate together with the old" elements of the combination "so as to make the 'new' unitary apparatus perform its designed function"? (Quotations from *Halliburton v. Walker*, 329 U. S. 8.)
2. May a patentee who has represented to the Patent Office in order to secure allowance of claims over an earlier patent cited by the Patent Office, that his structure is such that it operates in a specific and distinguishing manner, subsequently, in an infringement suit to enforce the patent, repudiate those representations and assert a different and contradictory manner of operation to reach an accused structure which operates differently from the patented structure and more nearly like the structure of the earlier patent?

* Decided by this Court after submission of the instant case to the Eighth Circuit Court of Appeals, and not mentioned in the latter's opinion.

Reasons Relied On For Allowance of the Writ.

The discretionary power of this Court to grant a writ of certiorari is invoked upon the following grounds:

1. The decision of the Circuit Court of Appeals in sustaining combination claims characterized by an assertedly "novel" element designated as an "actuator", a term of uncertain meaning not once used or defined in the specification, when the term is used in the claims without setting forth the structure or manner of operation of the "actuator", is in direct conflict with the decision of this Court in—

Halliburton Oil Well Cementing Co. v. Walker, 329 U. S. 1, 13.

2. The decision of the Circuit Court of Appeals in failing to limit the claims in suit by applicant's representations made to the Patent Office to distinguish them from an earlier patent is in direct conflict with the decisions of several Circuit Courts of Appeals that such representations made in argument must be observed in construing patent claims.

Gottschalk Mfg. Co. v. Springfield Wire, 74 F. (2d) 583, 587 (CCA 1).

Ladd v. Walker, 7 F. (2d) 72, 76 (CCA 3).

Wiegand et al. v. Bingham Co., 106 F. (2d) 546, 548 (CCA 6).

Sager v. Glove Corp., 118 F. (2d) 873, 874 (CCA 7).

3. The decision of the Circuit Court of Appeals is in direct conflict with the decision of this Court in—

Permutit Co. v. Graver Corporation, 284 U. S. 51, 57-58.

4. The question presented by this petition is an important question with respect to the administration of the patent laws, as the decision of the Circuit Court of Appeals permits a patentee to take one narrow position with respect to the claims he seeks during the prosecution of the patent in the Patent Office, and thereafter to repudiate the necessary limitations of the claims as represented to the Patent Office and claim a far greater scope for the claims in asserting them against the public.

5. "The far-reaching social and economic consequences of a patent, therefore, give the public a paramount interest in seeing that patent monopolies spring from backgrounds free from fraud or other inequitable conduct and that such monopolies are kept within their legitimate scope." *Precision Instrument Mfg. Co. v. Automotive Maintenance Machinery Co.*, 324 U. S. 806, 816.

**Summary Statement of the Matter Involved.
In Brief.**

The five combination claims of the patent in suit contain a term, "actuator", not mentioned in the specification. Its only definition was in representations made in argument to the Patent Office to induce allowance of the claims. These representations were ignored by the Circuit Court of Appeals, which followed its earlier opinion in *Smith v. Mid-Continent Investment Co.*, 106 F. (2d) 622, 627, to the effect that statements by the applicant would not be considered "as the possible basis of estoppel".

The claims further lack any definition of the "actuator" or of "the structure, mode, and operation of the parts in combination," as required by this Court in *Halliburton Co. v. Walker*, 329 U. S. 1, 8. The Circuit Court of Appeals, although stating, "The heart of the combination is the actuator," satisfied itself with the statement, "Each of these claims states the physical combination of the various mechanical elements and their functional inter-relationship and operation" (R. 679).

The Circuit Court of Appeals found that the accused device was specifically different as to structure and function from that of the patent but found a functional correspondence in the production of each of a principle of operation called "feel" (see pages 19-21 below). The Court, although stating, "The patent nowhere contains the word 'feel'" (R. 682) held that because of this undisclosed teaching of "this governing principle * * * he (Kesling) is entitled to a reasonably liberal range of protection" (R. 686).

The sustained claims do not set out the connections between the elements necessary to produce "feel".

The Background.

Respondent, Kesling, invented a mechanism to aid in the manual shifting of gears in an automobile transmission, by which the operator performed the gear shifting in the conventional way until the gears were initially enmeshed and a conventional vacuum operated cylinder then took over and completed final movements of the gear shifter without further aid or control by the operator.

For years the standard automobile transmission contained an arrangement of gears to change the ratio of engine speed to rear wheel speed and to enable the car to be reversed (R. 209). This change was accomplished by manual movement of a gear shifter lever through a range of movements which make the letter H, thus—

Reverse	Intermediate
H	
Low	High

The transverse movement across the bar of the H selected one of two "rails", and movement along the legs of the H moved a shifter fork (in the patent called "shifter element") which brought a complementary pair or series of gears into meshing engagement. The engine was disconnected from the transmission during the shifting by operation of the clutch, and the connection was restored upon the completion of the shift by release of the clutch pedal (R. 35, 171-175).

Numerous patents appear in the prior art showing various devices for making the gear shift by vacuum power with manual or automatic control of the power (R. 330-337; R. 340-342; R. 388-392; R. 442-450).

Similarly several patents show the use of vacuum power to operate brakes on automobiles (R. 352-359; R. 367; R.

370-378; R. 380-383; R. 412-415; R. 418-422; R. 423-433), automobile steering mechanism (R. 436-439), and, as one patent says, "to provide a power actuator for the operation of brakes, gear shifts, clutches, steering gear, or other devices ordinarily operated manually, by hand or foot * * *" (R. 394-410, at 399).

As early as 1926, boat reverse gears had been operated by vacuum cylinder motors of the same type (R. 37, 45, 47).

The Moorhouse Patent No. 1,993,015 (R. 442-450; See Plate II at the back of this brief), applied for September 17, 1932, showed a vacuum cylinder power shifter for automobile transmissions. The manual shifter lever operated a valve through a control linkage by which, as long as the lever was moved in either direction, the vacuum cylinder was energized to move the shifter forks in the same direction. If for any reason the power was not available, the manual shifter lever did the shifting by hand with the same movement.

The Kesling Invention Was of a Gear Shifter in Which Manual Force Alone Was Used Initially to Engage the Gears and Thereupon Power Alone to Complete the Final Movements of the Shift Pursuant to a Timed Relationship Inevitable in His Structure.

Respondent's patented invention (R. 606-616) was of a device associated with the driver's manual operating lever and the transmission, by which the driver was able to make the shift in the conventional way until the complementary gear teeth initially enmeshed, whereupon a dump valve was relieved and a vacuum cylinder completed the shift in its final movement by power and without manual aid, or control.

The essential and critical features of Kesling's shifter lay in a structure by which the operator initially enmeshed the gears by manual force alone, and then released the vacuum power control valve which applied power *alone* to complete the shift. The operator had only manual force to move the gears (as well as the additional dead load of the inactive piston, piston rod, and associated parts) from neutral into initial engagement. He had no part in or control over the completion of the shift by power.

When the operator sought to shift from one gear (*e. g.* low), to another (*e. g.* intermediate or second), the operator was compelled to move the gears (and inactive piston, etc.) by manual effort alone from the old engaged position through neutral, and on until he had reengaged the gears in the newly selected position, whereupon the vacuum cylinder took over and completed the shift.

This is the only way the structure of the Kesling shifter can work. It is also the only structure and method of operation shown in the Kesling drawings and described repeatedly in his specification:

"Objects of the invention are to provide a gear shifting mechanism having manual means for imparting the initial movements thereto in shifting operation, and means for utilizing the operation of the engine or motor to impart the final movements to the shifting operations without the application of additional manual force to effect such final shifting movements; to provide a construction whereby the energy or force of the engine or motor will continue to operate or function without interruption until the shifting operation has proceeded to a predetermined extent;" (R. 611, col. 1, ll. 5-16.)

* * * * *

"Each of the cylinders 43 and 44 is equipped with valve mechanism controlling the ports 45 and 46 and

co-ordinated with the remainder of the invention in order to cause the engine or motor to impart the final movements to the shifting mechanism after the initial movements have been imparted to the shifting mechanism manually." (R. 612, col. 2, ll. 32-39.)

"Then the shaft 27 is moved longitudinally and the spindle 10 is turned thereby, thus imparting an initial lateral shifting movement to the fork 5 and an initial turning movement to the intermediate cam * * * to close the air inlet port 47 and to open the suction port 51.

"At this point the suction of the engine is from the cylinder 43, thereby operating the piston 40 to impart a final turning movement to the spindle 10, and thereby a final shifting movement to the fork 5 and the device operated thereby." (R. 613, col. 2, ll. 61-75; R. 614, col. 1, ll. 1-3.)

These and several other similar passages were in the Kesling specification as filed. The 20 claims originally filed were generally very specific and confined to the structural elements described in the specification, or the specific timed sequence of operations separating the initial manual operation from the final power operation, without manual aid or control (R. 91-105).

The word "actuator", which appears in each of the claims in suit, was first used by Kesling in his original claims 16-20 (R. 103-105). This term was nowhere mentioned or defined in the specification.

The Patent Office and Kesling agreed that this nebulous and undefined term referred to the unitary spindle and the cams and gears rigidly secured thereto (See Plate I at the back of this Brief), and that this structure necessarily produced the timed separation of the shift into an initial manual portion and a subsequent power portion without manual aid or control.

Throughout the Prosecution of His Application Kesling Consistently Urged That His Invention Distinguished From the Prior Art in the "Definite Timed Relationship" Between the Manual and Power Functions of His Shifter.

Prior to the insertion of the claims in suit Kesling had urged that his invention distinguished from the prior art then cited in the separation of the shifting operation into an initial manual portion and a subsequent power portion (R. 121, 135, 139).

On April 30, 1935, after the application had been pending about two years, the Patent Office cited the Moorhouse Patent No. 1,993,015 (R. 442-450) which had issued March 5, 1935, and was effective prior art to Kesling, and rejected a large number of claims previously allowed as fully met by Moorhouse.

Moorhouse (See Plate II) showed a shifter in which a conventional hand shift lever operated a valve control linkage to operate a valve producing a follow-up control of a suction motor which furnished the power to move the gear shifters. The suction power was applied throughout the movement of the shifters, always under full control of the hand lever. Whenever movement of the hand lever was halted the motor stopped.

The Moorhouse patent shows (See Plate II) a conventional gear box with shifter elements or forks, a control linkage or "actuator" comprising three interpivoted levers (colored red), a suction motor (yellow), a valve (blue), and a manual lever (27). The shifter elements, suction motor, valve and the manual lever are all connected to the control linkage so that the shifter elements are moved by the suction motor under the continuing control of the manual lever.

Moorhouse did not use manual force initially to engage the gears and thereafter uncontrolled power only to complete the shift.

Kesling urged this distinction in persuading the Patent Office that the Moorhouse patent was not applicable. When he added the six claims which issued as claims 25 to 30 inclusive, of which 25 to 29 are involved in this suit, he urged their allowance on the same ground of distinction from Moorhouse, saying:

"As to claim 15, Moorhouse does not disclose any operative combination of elements including manual mechanism for moving the shifter elements for only an initial portion of their movements and suction mechanism cooperating with said manual mechanism in timed relationship for imparting only the final movements to the shifter elements. Neither does Moorhouse disclose said manual and suction mechanism operating in the timed relationship mentioned in combination with means preventing operation of the suction mechanism until the manual mechanism has been operated to impart the initial movements to the shifter elements throughout their movements.

"Claims 16, 17, 18, 19 and 20 have been amended to include positively the suction mechanism that moves the devices operated thereby through *only* their final movements leaving it to the manual means to move said devices through their initial movements. Moorhouse does not disclose these elements combined and functioning in this way.

"Claim 23 has been similarly amended and claims 24 and 25, as amended, now distinguish from Moorhouse more clearly than before. The amendments inserted in said claims distinguish clearly from Moorhouse, which reference does not disclose the limitations brought into said claims by these amendments.

"The new claims are presented in view of Moorhouse and said claims include elements combined in a novel cooperative relationship and operating in a

novel timed relationship, clearly different from Moorhouse. That is to say, that said claims include manual means for moving the shifter elements initially and vacuum or power means brought into operation later, and after operation of the manual means, and in definite timed relationship to the operation of said manual means to move the parts through their final movements.

"In these particulars applicant's invention distinguishes quite clearly from Moorhouse and it is thought that the application, as now amended, is in condition for allowance which will be appreciated" (R. 159-161).

The "definite timed relationship" to which applicant referred was the same essential and critical feature of the Kesling device which had been emphasized and reiterated throughout the specification and the prolonged argument in the Patent Office, whereby manual force alone was employed to effect initial engagement of the gears and thereafter power alone employed to complete the shift. But, the claims adroitly adumbrated this clear distinction by using the undefined term "actuator" in each claim four or five times.

The Patent Office required a few formal changes and these were made, as Kesling said, "bringing in the valve whereby the actuator controls the suction mechanism to cause the suction mechanism to function at the proper time" (R. 165).

Thereupon the patent issued.

The Circuit Court of Appeals Recognized This Distinctive Feature in the Kesling Shifter, Whereby Manual Force Was First Used Alone to Make Initial Engagement of the Gears and Power Only to Effect Their Final Movement.

In its opinion the Circuit Court of Appeals repeatedly recognized not only the distinctive feature of the Kesling structure which induced the Patent Office to grant the Kesling patent, but also the inevitable difficulty that this involved in adding to the labor the operator was required to perform in the initial movements of the shift because of the unavoidable load the dead piston and related mechanism imposed. The Court said:

“The operation of this mechanism is as follows. Movement of the handle causes rotation of the spindle which is communicated to the cam causing its rotation. The rotation of the cam acts upon the shifter mechanism and also upon the power piston rod. Continued manual force causes further movements of the shifter mechanism toward the desired gear and of the piston rod toward the power valve. The results of this continued force by hand is that the gear shift gears are shifted to the point of initial meshing; at which time the valve becomes open; the power then takes over and pushes the gears into full mesh. The disclosures of the drawings and the Specification show that the preferred structure* contemplated use of manual force up to and into the beginning of the mesh with the desired speed gear and that, at that point, the vacuum power comes into play; takes over and completes the mesh” (R. 681).

* * * * *

“In Kesling's preferred form,* the hand begins and, without aid of power, carries the shifting operation to

* The patent nowhere mentions any other structure than the specific form shown or suggests that any alternative method of operation is desirable.

initial meshing with the desired speed ratio gear; at which point, power comes in and completes the mesh" (R. 693).

* * * *

"It is clear that Kesling *increases* the load of the 'initial' hand operation up to point of meshing gears to the extent of the 'drag' of the power unit pistons and that he *entirely relieves* the hand from any load in the 'final' operation of meshing the gears" (R. 674).

The Court's difficulty in giving the claims any precise scope arose from the presence of the undefined word "actuator."* After quoting the five claims in suit the Court said:

"Analysis of any of these claims reveals a combination mechanical structure composed of gear shift elements, manually operated elements, power operated elements and an 'actuator.' The heart of the combination is the actuator. To it, the shift, the manual and the power elements are all mechanically connected" (R. 679).

If the term "actuator", never defined in the patent, has any meaning in this case it is that given it throughout the case by Respondent and assumed for the purposes of discussion by Petitioner, the spindle with rigidly secured gears and cams colored in red on Plate II. As a connector

* That the term "actuator" has the loose, general meaning of such terms as "means" and "mechanism" appears from the following interrogation of defendant's engineering expert by plaintiff's counsel:

Thomas: " * * * The term seems to be very broad and means many things."

"Q. In other words, you certainly do not contend that an actuator cannot be made up of a group of parts that move relatively to each other?

"A. That is right, I do not; except an actuator probably could be called a mechanism or by some other term.

"Q. In other words, we might have substituted in our discussions here the term mechanism instead of the term actuator?" (R. 545)

between the hand levers, the suction valve (blue) and piston-driven rack (yellow), it necessarily established a "definite timed relationship" in the operation of the shifter because the gears, cams, etc., are secured together rigidly. The sequence of operation was invariable, and power was applied *only after* the hand alone had effected initial engagement of the gears.

The Accused Chevrolet Shifter Is Wholly Unlike the Kesling Device in Structure, Function and Result.

The Chevrolet gear shifter (See Plate II) employs a standard transmission with manual controls mounted on the steering wheel post. A suction motor is mounted adjacent the transmission and is controlled by a valve mounted within the piston rod.

A valve control linkage comprising three interpivoted levers, sometimes called a re-action linkage is interposed between the hand lever, piston, valve and the transmission shifter elements or forks. This valve control linkage is in principle that patented in the DeWandre Patent No. 1,869,956 (R. 424-433) where it is shown on power-operated brakes (See also R. 567). This linkage works on the same principle as the double-tree on a wagon, dividing the load between the hand lever and the piston, just as a double-tree divides the load to be borne by each horse of a team.

In the Chevrolet shifter the control linkage is so designed that the vacuum motor provides 80% and the operator 20% of the effort of shifting gears throughout the entire shifting operation. Because of the share of the effort constantly imposed on the operator, he is constantly aware of the progress of the shifting operation. Because a follow-up valve control is used (as in the Moorhouse

patent) the manual effort must be continuously applied or all movement stops. The District Court made a special finding on this:

"Defendant contends, and I am convinced it is true, that the proportion of force exerted by power is about 80%, and the proportion of force exerted by the hand is about 20%. The combined forces of the two bring about movement of the shifter lever. The hand, in operating the shifter lever, is the dominant influence in the operation and without the control by the hand throughout the operation, the operation would not be carried on, *i.e.*, the manual force dominates the mechanical force and whenever the movement of the hand stops, the operation in shifting the gears stops" (R. 640).

In the Chevrolet shifter (unlike Kesling) there is no time when the gear shifters are moved either entirely by hand or by hand before the suction motor is energized and active, no time when the power is effective without continued manual pressure upon the control levers. This method of operation is briefly described by the Circuit Court of Appeals:

"The method of operation of the accused device is as follows. Manual force initiates and continues throughout the entire shift operation. This manual force is first communicated to the valve lever which starts opening the valve port; continued manual pressure on the valve lever takes up any 'lost motion' clearance in the linkage between the valve lever and the reaction lever then causing movement of the reaction lever; still continued manual pressure takes up any 'lost motion' clearance in the linkage of the shifter lever then causing the shifter lever to start moving the gear shift elements; power force comes into exertion (through the piston rod connection to the reaction lever) upon the reaction lever and, through linkage, upon the shifter lever at least as early as the beginning of movement of the shifter lever; the com-

bined manual and power force continue the shifting movement to completion or until halted by withdrawal of manual force. The manual force is necessary not only to initiate the entire shifting operation but also continuously until the operation is completed. This is true because of the type of valve which activates the power unit. This is a 'follow up' type. This valve is positioned within a hollow piston rod so that, when the valve is opened, the thus admitted power causes the piston to move in the same direction as the valve is opening. If the hand pressure is stopped, the continued movement of the piston will close the valve port. Thus this hand pressure must be continued to keep the valve open and ahead of the piston movement or power force will be cut out. This manual control of the valve gives the driver complete control of the power; so that by continuing sufficient hand pressure, he can keep the valve port fully open, securing full force of the power unit; or by lessening the pressure, he can allow the port to close, shutting off power. It is not out of place to note that an entire gear shift operation is a matter consuming only seconds of time.

"Concisely, this method of operation is manual force admitting power force before any consequential movement of the gear shifting elements and, from there on throughout the entire normal gear shifting operation, a unison of manual and power forces with complete control in and mechanical connection with the hand of the driver—permitting 'feel'—up to completion of the gear shift" (R. 692-3).

Clearly in the Chevrolet shifter the suction mechanism and the manual mechanism do not operate in a "novel, timed relationship," as Kesling represented of his device and the claims in suit to the Patent Office when he said:

"That is to say, that said claims include manual means for moving the shifter elements initially and vacuum or power means brought into operation later, and after operation of the manual means, and in definite

timed relationship to the operation of said manual means to move the parts through their final movements" (R. 161).

It is clear why this is so. The Chevrolet shifter has no single unitary element forming an "actuator" to insure manual movement of the shifter elements prior to opening of the valve to produce Kesling's "timed relationship."

The control linkage in the Chevrolet shifter which Respondent asserts to be an "actuator" is composed of three levers pivoted together to permit them to move relatively to each other throughout their operation. Their respective positions are constantly altering. It is only through this continuing change in the relative positions of the control levers to each other that the valve is operated to insure constant control by the operator, and the load is distributed between the operator's hand and the suction motor, functions and results wholly absent from the Kesling structure. (The control linkage in the Moorhouse structure functions similarly, but because of the location of the pivots imposes no part of the effort of shifting on the operator).

Because of the Indefiniteness of the Claims the Courts Below Were Able to Ascribe to the Kesling Patent a Scope Capable of Embracing Every Shifter Mechanism Using Power and Capable of Producing a Function Called "Feel",* Regardless of the Construction of the Mechanism or the Manner in Which it Functions to Produce "Feel", Though "Feel" Is Not Mentioned in the Patent or Argument Before the Patent Office.

The trial court and the reviewing court conceded that the structures of the Kesling Patent and the Chevrolet gear shifter were different, that the sequences of operation thereof were different, and that the results accomplished thereby were specifically different.

But the trial court and the reviewing court concluded that both the Kesling construction and the Chevrolet construction have "feel" at the critical point of initial meshing of the gears. Only because of this functional similarity of the two constructions and because "the claims failed adequately to depict the structure, mode, and operation of the parts in combination," (*Halliburton Co. v. Walker*, 329 U. S. 8), was it held that the Chevrolet construction infringed the Kesling patent.

The specification of the Kesling patent and the arguments advanced before the Patent Office are completely silent on "feel". The presence of "feel" in the Kesling construction and its importance as a part of the Kesling patented invention were concocted for the first time at the trial of this case.

The function of "feel" has been present universally in

* "Feel" may be defined as the variation in resistance to movement encountered at different portions of the shifting operation. These variations follow a characteristic pattern and enable the operator, after becoming familiar with the pattern, to recognize immediately which of the several possible positions the gears occupy.

every manual gear shifter ever used. In the Kesling structure "feel" is present in the initial portion of the shifting movement only because shifting is purely manual at this time; as soon as power is applied, "feel" is destroyed. Thus "feel" and the specific "timed relationship" of the Kesling patent are completely interdependent; without one the other cannot exist.

In the Chevrolet construction, the "feel" is not that resulting from conventional manual shifting to the point of initial meshing of the gears, as in Kesling. The Chevrolet control valve linkage, through relative movement of its interpivoted levers, distributes the resistance to movement of the gear shifter elements between the hand lever and the suction motor. This makes the operator a sentient participant in the shifting operation through its full range of movement and reproduces for him, in miniature, the complete resistance pattern of normal manual shifting. "Feel" is the inevitable concomitant to power in the Chevrolet structure.

The Circuit Court of Appeals admitted that the patent did not mention "feel" (R. 682) but held that "because he (Kesling) uncovered this governing principle * * * he is entitled to a reasonably liberal range of protection" (R. 686).

The combination claims sustained do not set out the connections between the elements which are necessary in a structure to produce "feel", and the catalog of elements which forms each of these claims can be arranged in various ways to produce structures of the prior art as well as the Kesling structure, with or without "feel".

Not only are the combination claims mere catalogs of elements but one of those elements is the undefined "actuator".

These patent ambiguities in the claims are further ob-

scured by the refusal of the courts below to give effect to the only concrete expression of their meaning, that found in the argument made to the Patent Office which induced allowance of the claims.

The questions raised by combination claims of this type and the courts' refusal to consider the patentee's representations to the Patent Office as to their meaning are important questions in the administration of the patent law.

Wherefore, it is respectfully submitted that this petition be granted and a writ of certiorari be issued to the Circuit Court of Appeals for the Eighth Circuit.

Respectfully submitted,

HORACE DAWSON,
CASPER W. OOMS,
Counsel for Petitioner.

Chicago, January 28, 1948.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1947.

No. _____

GENERAL MOTORS CORPORATION,

Petitioner,

vs.

ELMER G. KESLING,

*Respondent.***BRIEF IN SUPPORT OF PETITION FOR A
WRIT OF CERTIORARI.**

Patent Claims, Unlike Ordinary Contractual Instruments, Are Negotiated Without the Participation of Those Affected by Them, and to Insure That the Claims "Are Kept Within Their Legitimate Scope": It Is Imperative That the Claims Scrupulously Comply with All Representations Made to the Patent Office.

This Court, in a series of decisions culminating in *Mid-Continent Investment Co. v. Mercoid Corporation*, 320 U. S. 661, has established the limits of the economic scope of United States Letters Patent. The question of the technical scope of patent claims is of equal public importance and requires clarification of the effect of many of the accepted practices in the solicitation and interpretation of patent claims.

It has long been the established doctrine in this Court that a patentee who cancels claims from his patent or introduces limiting amendments into claims may not thereafter assert for those claims a scope coordinate with the cancelled claims or rejected and amended claims. *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U. S. 126.

This Court has similarly held that limiting material removed from a patent specification during its prosecution in the United States Patent Office would not be ignored in the interpretation of the patent claims. *Mackay Radio & Telegraph Company v. Radio Corporation of America*, 306 U. S. 86, 101.

This Court has impliedly gone farther in *I. T. S. Rubber Co. v. Essex Rubber Co.*, 272 U. S. 429, where it emphasized the effect of the argument of the applicant as bearing upon the construction to be accorded claims brought into litigation. While that case involved a reissue application in which the claims were amended during the prosecution, the Court six times referred to the meaning given to the claims by the applicant in his argument to the Patent Office (272 U. S. 437, 438, 440, 441 and 442).

The implication of these decisions is inescapable. Patents are "affected with the public interest" and because their "far-reaching social and economic consequences * * * give the public a paramount interest in seeing that patent monopolies * * * are kept within their legitimate scope," (*Precision Instru. Mfg. Co. v. Automotive Maintenance Machinery Co.*, 324 U. S. 806, 816), it is important that this Court speak clearly and unmistakably upon the question of whether representations made in argument to the Patent Office to secure a patent are of substantial consequence in the interpretation of that patent when it is asserted.

The Circuit Courts of Appeals have been in irreconcilable conflict upon the question whether any weight should be

accorded to the argument made by an applicant in the Patent Office to overcome objections to the issuance of his patent.

"Some courts give consideration to arguments, as well as to cancellation, made in the office by the applicant, and even to statements made by the examiner; other courts refuse to consider such arguments or statements." (*Outline of Patent Law, Stringham, 1937*, p. 326.)

Some courts have looked upon a patent as merely a contract in which the negotiations and intent of the parties are merged in a final expression in the form of claims which may not be modified or interpreted by a disclosure of the negotiations which led to its expression, except by a comparison of altered or canceled claims with those issued.

"We take this occasion, however, once more to say that in the consideration of a file wrapper we do not look at the arguments of the applicant to the examiner. We wish it to be understood that, as we conceive the purpose for which the file wrapper can be examined, it covers simply the question of estoppels through rejected claims. The whole doctrine is somewhat anomalous at best, since it involves looking at preliminary negotiations in the interpretation of a formal document intended to be the final memorial of the parties' intentions. The practice, however, is too well settled for us to disturb, and we have no intention of casting any doubt upon it. This court, nevertheless, has twice already disapproved the practice of bringing into that interpretation the arguments of an applicant. * * * We repeat now that disapproval."

Spalding v. John Wanamaker, 256 F. 530, 533-534 (C. C. A. 2, 1919).

"But the claim in suit does not limit the construction to a rotary valve, and the statement of the solicitor in the course of the Patent Office proceeding to this effect may not be carried into the claims allowed. It seems

likely that he had reference to claims subsequently rejected, which contained this limitation. Whether or not this was his meaning, it is the language of the claim, and not the argument of patent counsel which controls. Of course the claim as allowed must be read and interpreted with reference to the rejected claims, and to the prior state of the art, and cannot be construed to cover what was rejected by the Patent Office or disclosed by prior devices. *Doughnut Machine Corporation v. Joe-Lowe Corp.*, (C. C. A. 67 F. (2d) 135). On the other hand, the solicitors' arguments of themselves set up no estoppel."

Denominational Envelope Co. v. Duplex Envelope Co., 80 F. (2d) 186, 192. (C. C. A. 4, 1935.)

"Appellant relies upon certain rejection of claims by the Office and also upon certain statements of the Examiner and of the applicant. Under the rule above stated, we consider only the rejection and substitution of claims as the possible basis of estoppel."

Smith v. Mid-Continent Inv. Co., 106 F. (2d) 622, 627, (C. C. A. 8, 1939).

"The appellant relies on the rule recognized in the decision of this court in *Fullerton Walnut Growers' Association v. Anderson Co.*, 166 Fed. 443, 92 C. C. A. 295, that where the claims of a patent are not ambiguous they are not controlled or limited by any argument or representation made by the patentee's attorney before the Patent Office as to the scope of the invention or the features in which it differs from the prior art. But while admissions in the file wrapper may not be adverted to as enlarging or diminishing or varying the language of the patent thereafter issued, they have value in the present case as indicating the construction that should be put upon the claims."

Warren Bros. Co. v. Thompson, 293 F. 745, 747 (C. C. A. 9, 1923).

American Laundry Mach. Co. v. Strike, 103 F. (2d) 453, 456-457 (C. C. A. 10, 1939).

This Court in 1934, in *Keystone Driller Co. v. Northwest Engineering Corporation*, 294 U. S. 42, 48, where the question was not directly presented because the claims were limited during the prosecution so that a clear case of file wrapper estoppel was presented, stated:

"We do not attribute the force of an estoppel to what was said by the claimant in seeking to avoid the prior art cited against his broad claims, but we do apply the principle that where such broad claims are denied and a narrower substituted, the patentee is estopped to read the granted claim as the equivalent of those which were rejected."

Other courts have held the patentee to a scrupulous regard for the representations made to the Patent Office to secure the issuance of the claims.

"A patentee will not be permitted to repudiate a construction which he has put upon a claim in a communication to the Patent Office in order to obtain the allowance of it."

Gottschalk Mfg. Co. v. Springfield Wire, 74 F. (2d) 583, 587, (C. C. A. 1, 1935).

"With these repeated admissions of the Milne and Edgar disclosures and attempted avoidances thereof, Ritts is estopped from now claiming novelty in a high arch construction, so far as more height is concerned."

Ladd v. Walker, 7 F. (2d) 72, 76 (C. C. A. 3, 1925).

"We are aware that in some jurisdictions reference to file wrapper history to ascertain the meaning of claims is looked upon with disfavor except insofar as it covers the question of estoppel through rejected claims. *Spalding & Bros. v. Wanamaker*, 2 Cir., 256 F. 530. This is on the ground that it involves looking at preliminary negotiations in the interpretation of a formal document intended to be the final memorial to the parties' intentions. We have not so tightly closed the door to inquiry upon the precise concept of the inventor measured by his own representations."

Wiegand v. Bingham Co., 106 F. (2d) 546, 548, (C. C. A. 6, 1939).

"The argument employed before the Examiner to obtain his patent—i.e., that the disclosure of a glove made from a single piece of material was a patentable improvement, defeats his contention of infringement by defendant's glove made from two pieces of material."

• • • • •

"By the argument, however, which induced the issuance of the patent, it is plain, so we think, that there is no infringement."

Sager v. Glove Corporation, 118 F. (2d) 873, 874, (C. C. A. 7, 1941).

In determining the acceptable line of authority on this question it must be remembered that the solicitation of patent claims is an *ex parte*, secret procedure in which the potential infringer, the manufacturer, the public, may never directly participate.

In soliciting his patent, Kesling repeatedly urged upon the Patent Office that his invention consisted in a mechanism providing a novel "timed relationship" with initial manual shifting followed by subsequent power shifting. He never attempted to distinguish the claims here in suit or other similar claims from the cited prior art on any other basis. His disclosed structure could operate in no other way.

From a reading of the Patent Office actions and the Kesling arguments there can be no doubt that both the Patent Office and Kesling so understood the claims when they were allowed. It was only upon this understanding, based upon Kesling's repeated representations that the Patent Office issued this patent.

Certainly the Patent Office did not allow the Kesling patent because it showed a mechanism providing "feel" when "feel" was never mentioned.

Yet in this suit, Kesling urged, and the Courts below held, that the "timed relationship", absent in the Chevrolet structure, could be completely ignored. "Feel", for which there was no definition to embarrass Kesling's expanding concept of his invention, suddenly became the "governing principle" of the Kesling invention because the Chevrolet shifter could not employ Kesling's "timed relationship" but did provide "feel", albeit of an entirely different type from that attributed to Kesling.

If a patentee may, as was done here, describe a single, specific structure in his patent specification, procure general, functional claims distinguished from the prior art only upon his representations of a specific and inevitable method of operation, then repudiate these representations and have the patent sustained as embracing all structures which possess an undisclosed, functional principle ("feel"), the statutory demand for a distinct claim of invention will be abrogated.

A Patent Claim, Unlike Other Contractual Instruments, May Not Have Its Ambiguities Resolved by a Reconstruction to Meet the Needs of Each Suit in Which It Is Asserted, But Must Satisfy the Statutory Demand That It "Distinctly Claim" the Invention.

While in some respects a patent may be like a contract, another important distinction must be ever present:

There is no statute to dictate that contracts, to be valid, must be expressed with a clarity beyond dispute. The patent statute dictates that a patentee shall—

"file in the Patent Office a written description" of his invention "in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the

same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery." (R. S. 4888; Title 35, U. S. Code, Sec. 33.)

The statutory command that a patentee "shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery," is clear beyond any need for explanation or justification. This Court has repeatedly been compelled to invalidate patent claims for failure to comply with this elementary requirement.

There are many reasons besides the express terms of the statute why the demand for clarity in patent claims applies with special force to claims for a combination.

The entire concept of a patentable combination derives its vitality only from the arrangement of the elements in such a manner that the combination effects a new result and not merely the aggregate of the respective results of the respective elements. *John E. Thropp's Sons Co. v. Seiberling*, 264 U. S. 320, 326-327.

No mere catalog of elements can ever meet the requirement of a combination claim. If it could, the several elements indiscriminately connected could be made the subject of a patent claim. It is inconceivable that the law would tolerate a monopoly of such elastic scope.

A combination can be expressed only by a precise definition of the structure in which the elements are not only precisely named but their interconnections and manner of operation are established. Absent these limitations the catalog of elements does not depict a combination. *Halliburton v. Walker*, 329 U. S. 1, 8, 12.

There is nothing new in this principle. In 1879, in the case of *Parks v. Booth*, 102 U. S. 96, 102, this Court, in considering the statutory adequacy of combination claims said:

"Patented inventions are also made which embrace both a new device or element and a new combination of old devices embodied in the same apparatus or machine. Particular description of the improvement is required in such a case, as the property of the patentee in such a case consists not only in the new device, but also in the new combination."

"Modern inventions very often consist merely of a new combination of old elements or devices, where nothing is or can be claimed except the new combination. Such a combination is sufficiently described, to constitute a compliance with the letter and spirit of the Act of Congress, if the devices of which it is composed are specifically named, their mode of operation given, and the new and useful result to be accomplished is pointed out, so that those skilled in the art and the public may know the extent and nature of the claim and what the parts are which cooperate to do the work claimed for the invention."

We are confronted in this case with a patent which contains nothing but combination claims. Many of those claims are specific to the structure which Kesling produced and which he illustrated and described in his patent. With those claims we have no quarrel. They are not in suit.

The claims in suit, however, are merely catalogs of the following five elements:

1. "Gear shifter elements"
2. An "actuator" for moving the shifter elements
3. "Suction mechanism" or "operating means" for operating the actuator
4. A "valve" controlled by the actuator
5. "Other means" or "manual means" for moving the actuator.

Even were it possible to identify the specific structure purported to be designated by the word "actuator", there is nothing in these elements that insures that a structure comprising them will operate in the manner described in the Kesling patent and relied upon by the Circuit Court of Appeals as incorporating that nebulous, unmentioned principle of "feel".

Kesling's device has a specific timed relationship to which he repeatedly adverted in the Patent Office as distinguishing his structure from that of Moorehouse. That timed relationship can be established only if the "actuator" is solely manually controlled until the gears are initially enmeshed. There is no such limitation in any of the claims.

The structure shown in the Kesling patent inevitably produces a timed operation and that is the only reason the Kesling structure produces "feel". This result—the only new result attributed to Kesling—is present only because of the specific form of Kesling's so-called "actuator", and the specific arrangement of the elements of the combination. But the claims are wholly silent on these critical and vitalizing essentials.

The danger of mere catalog claims of the type here involved is evident from considering the variety of operations which would be possible by the indiscriminate arrangement of the combination elements which these claims permit.

The suction mechanism operates the actuator. The valve which regulates the suction mechanism is "controlled" by the actuator. How and when is the control exercised? Does the actuator open the valve which energizes the suction motor, or does it merely close the valve to stop the suction motor, or does it do both, and if so, when?

What are the "other means for initially controlling the actuator"? Where does the initial control begin and end?

What is the "actuator"? (See Plate I.) The patent specification not only fails to mention, identify or define it, but each of the claims mentions it four or five times and each time only in terms of either "what it will do" or what some other element will do to it.

"The language of the claim thus describes this most crucial element in the 'new' combination in terms of what it will do rather than in terms of its own physical characteristics or its arrangement in the new combination apparatus."

Halliburton v. Walker, 329 U. S. 1, 9.

This brief need not elaborate the very complete statement of the principles enunciated in that opinion. Every defect which was found by this Court in the Walker patent is present here. In addition the claims contain the undefined term "actuator" without either the claims or specification "showing its structure, its working arrangement in the alleged new combination, and the manner of its connection with the other parts". (329 U. S. 8.)

The sweeping generality of the term "actuator" is instantly disclosed by the chart (Plate I) which shows in phantom the structures with which the Patent Office and court were concerned in this case. The specific device to which the term "actuator" must be applied in the patent; the Chevrolet device to which the term "actuator" was applied by the court; and the prior art (Moorhouse) device to which the inventor refused to apply the term in the Patent Office, are outlined boldly.

The promiscuity of the term is evident from the fact that in the Kesling patent the moving parts to which the name "actuator" must be applied are rigidly interconnected and have an invariable "timed relationship" in their operation, while both the accused and prior art structures possess a

control unit in which the inter-pivoted parts are in a constantly altering interrelationship.

How can a term of this versatility ever serve in a claim without violating the statutory command?

A term of such generality has immeasurable advantages for a patentee. He may, if the courts permit, apply the term to any device which moves. In this case the patentee has done just that. When it became evident that the Moorhouse patent responded to the express terms of his claims he overcame the difficulty by representing to the Patent Office—without incorporating any of the distinguishing limitations into his claims—that the structure performed in a specific way, producing a “timed relationship”. Having thus disposed of Moorhouse in the Patent Office the patentee shed these representations because they were not incorporated into his conveniently functional claims. Thus, in litigation, the claims readily lent themselves to a different and contradictory construction, defying any effort to interpret them literally or to ascertain any limits to which they might be subjected in the application of the doctrine of equivalents.

If the statute is to permit this verbal hocus-pocus it will have lost all meaning and the warning of this Court in *General Electric v. Wabash*, 304 U. S. 364, 369, become but a hollow echo:

“Patents, whether basic or for improvements, must comply accurately and precisely with the statutory requirements as to claims of invention or discovery. The limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public. The statute seeks to guard against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their rights. The inventor

must 'inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.' "

The brief opinion of this Court in *Permutit v. Graver Corporation*, 284 U. S. 51, is directly in point. There a patent was sought to be enforced for a structure which allegedly was characterized by a " 'free' zeolite bed" which was neither mentioned in the specification nor in the claims although it was apparently indicated in the patent drawing. The trial courts had held, as the Circuit Court of Appeals did in this case (R. 682), that the novel feature was "necessarily 'presupposed' ", and the Sixth Circuit Court of Appeals held that if the structure shown involved a certain theory of operation it was not necessary that that be expressed. This Court bluntly rejected that approach and held (284 U. S. 51, 60) :

"The statute requires the patentee not only to explain the principle of his apparatus and to describe it in such terms that any person skilled in the art to which it appertains may construct and use it after the expiration of the patent, but also to inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not. The free bed was neither described in the specification nor claimed in either Claim 1 or Claim 5."

The numerous other cases in this Court which invariably apply the statute (R. S. 4888; Title 35, U. S. Code, Sec. 33) need not be cited. The statute in its terms is clear. Its purpose is manifest. Its violation in this case is inescapable.

Conclusion.

The patent sued on in this case presents a sweeping departure from the simple demands of clarity which the Patent Act imposes.

The claims in suit are all combination claims, in functional terms, and built about the undefined and undefinable term "actuator" without depicting "the structure, mode and operation of the parts in combination."

The successful efforts of the patentee to overcome the prior art in the Patent Office by specific representations as to the functioning of the patented structure, if incorporated into the claims, might have saved them as they alone lent the required certainty to the claim terms. The repudiation of these representations was permitted by the doctrine of the Eighth Circuit Court of Appeals, in conflict with that of several other circuits which permit the patentee to shed himself of the effect of representations made to the Patent Office to secure the issuance of the patent, when the patent is later brought into court.

The ascription to the patent of an undisclosed and unmentioned functional principle "feel" as the test of infringement substitutes for the requirements of the law a tenuous and evasive standard which offers no guide to the public and makes the patentee's imagination, rather than the patent, the definition of the monopoly conferred upon him.

It is therefore respectfully urged that this Petition for Writ of Certiorari be granted.

Respectfully submitted,

HORACE DAWSON,

CASPER W. OOMS,

Attorneys for Petitioner.

Chicago, Illinois,
January 28, 1948.

FILE COPY

Office - Supreme Court, U. S.
FILED
FEB 24 1948

CHARLES ELMORE GROPPY
SERIALIZED

IN THE

Supreme Court of the United States

OCTOBER TERM, 1947.

No. 558

GENERAL MOTORS CORPORATION,

Petitioner.

vs.

ELMER G. KESLING,

Respondent.

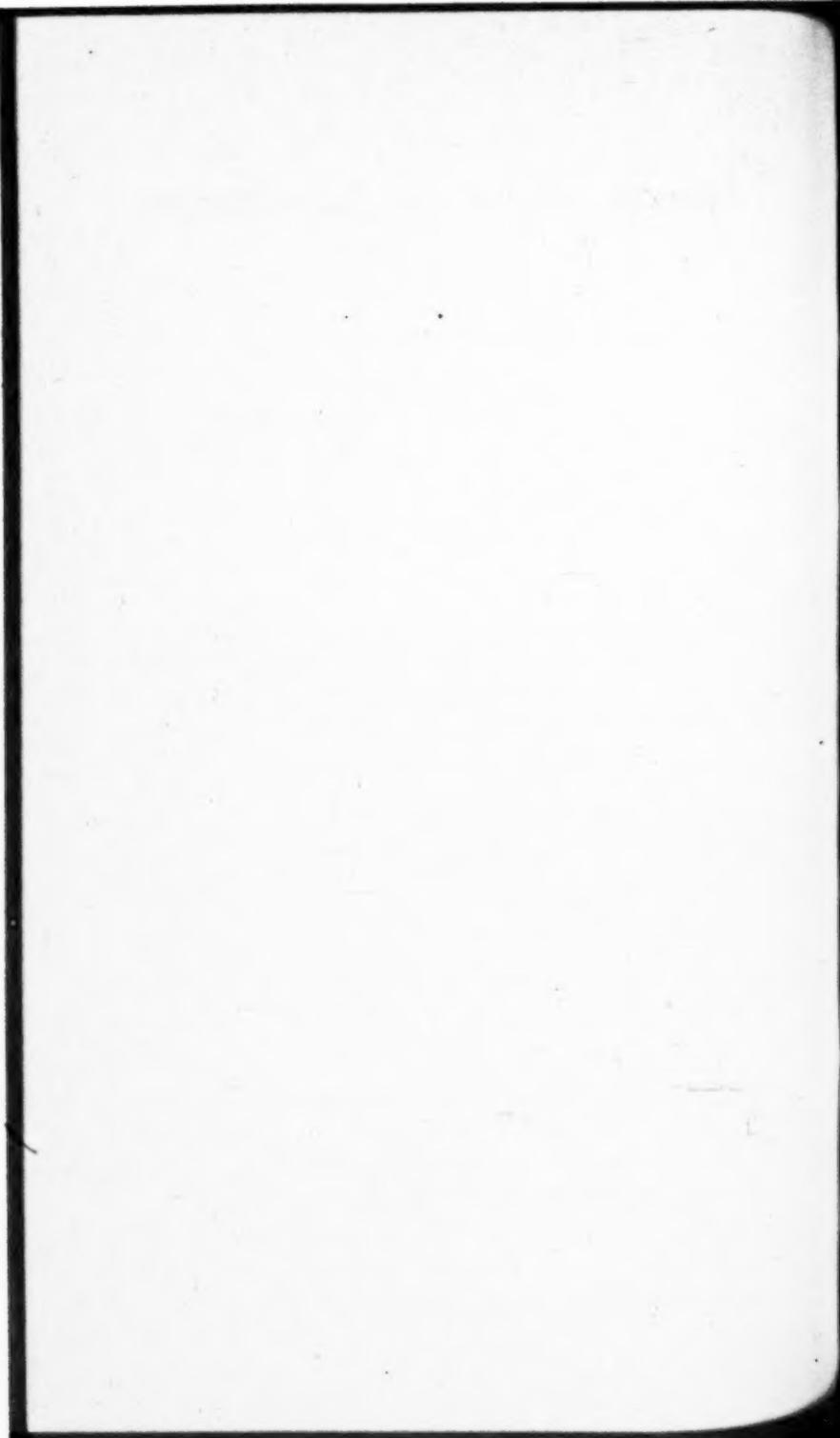
**PETITIONER'S REPLY TO RESPONDENT'S BRIEF
IN OPPOSITION TO PETITION FOR
WRIT OF CERTIORARI.**

HORACE DAWSON,

CASPER W. OOMS,

Attorneys for Petitioner.

EDWIN S. BOOTH,
JOSEPH J. GRAVELY,
Of Counsel.



IN THE
Supreme Court of the United States

OCTOBER TERM, 1947.

No. 558.

GENERAL MOTORS CORPORATION,

Petitioner.

vs.

ELMER G. KESLING,

Respondent.

**PETITIONER'S REPLY TO RESPONDENT'S BRIEF
IN OPPOSITION TO PETITION FOR
WRIT OF CERTIORARI.**

Respondent's reply to the Petition for a Writ of Certiorari merely takes refuge in the opinion of the Circuit Court of Appeals for the Eighth Circuit in this case. (R. 671-694; 164 F. (2d) 824.)

**Respondent Does Not Dispute the Existence of a Conflict
Between Circuits As To An Important Question of Patent
Law.**

Respondent does not dispute that in this opinion the "Circuit Court of Appeals has rendered a decision in conflict with the decision of another Circuit Court of Appeals on the same matter;" [Rule 38.5 (b) of this Court;] *i. e.*, the question whether representations made to the Patent Office to induce the issuance of a patent may be considered in the interpretation of the patent in litigation.

The Kealing Claims Are Clearly Functional and Flaunt This Court's Decision in *Halliburton v. Walker*.

Respondent contends that the Circuit Court of Appeals in this case has "found that the claims define precise interconnections between the handle, the actuator, the shifter element, the piston, and the valve." (Resp. Br. 3.) The Circuit Court of Appeals merely found, after setting forth the five claims in issue:

"Each of these claims states the physical combination of the various mechanical elements and **their functional interrelationship and operation.**" (R. 679.)

This is also evident from the claims. Respondent carefully avoids quoting them. All follow the same pattern. Claim 25 reads:

"25. Gear shifting mechanism of the character described comprising
gear shifter elements,
an actuator mounted for selectively moving said shifter elements,
suction mechanism connected to said actuator for operating said actuator to move said shifter elements,
a valve controlled by said actuator for regulating said suction mechanism, and
other means for initially controlling said actuator." (R. 187; 616; 679.)

Respondent argues that this claim complies with the prescription of this Court in *Halliburton v. Walker*, 329 U. S. 1. In that opinion this Court criticized the patentee's claiming a combination "in terms of what it will do rather than in terms of its own physical characteristics or its arrangement in the new combination apparatus." (329 U. S. 9.)

That criticism manifestly reaches the Kesling claims. There the actuator is described merely as "mounted for selectively moving said shifter elements." The suction mechanism, which is necessarily "connected to said actuator," is merely described "for operating said actuator to move said shifter elements." The valve is merely described as "controlled by said actuator for regulating said suction mechanism." And the anonymous "other means" is identified merely as something "for initially controlling said actuator."

No demonstration is needed of the complete functionality of these claims.

No findings of the Court or statement in the opinion of the Court of Appeals can find anything in these claims other than this functionally described mechanical melange.

This is all quite apart from the presence in this claim as its "heart," to use the language of the Circuit Court of Appeals, of the versatile, formless and undefined "actuator." The fact that that term appears in the claims and is not defined in the specification bothers Respondent not at all. Respondent says that "everyone who has been involved in this case has identified the actuator with no trouble." That may be true, as it would be impossible to contest an asserted infringement without assuming and assigning to the terms of the claim some meaning as a necessary hypothesis for the defense.

Respondent and Petitioner can, of course, identify what the "actuator" had to be in the Kesling structure. This was made apparent in the argument Kesling made to the Patent Office. The District Court also found,

"This actuator was a composite of members arranged to cause the hand lever and the power device to operate in a **timed relationship**." (Finding of Fact, 9; R. 638.)

The difficulty does not arise in identifying what must have been the "actuator" in Kesling's structure. The difficulty arises in the fact that the term, when presented in the claim without further particularization and with Kesling's representations to the Patent Office discarded, means anything that the patentee may assert it to mean, and that the claims thus fall short of compliance with the Patent Act (R. S. 4888; Title 35; U. S. Code; Sec. 33).

The law is not satisfied because in a given structure the word may be assigned a meaning. The statute demands clarity in the claims so that the world may know the limits of the monopoly accorded by the grant of the patent.

The sweeping and indiscriminating grasp of this terminology becomes apparent when the District Court's definition of the "actuator" (quoted from R. 638, page 3 above) is compared with the same court's definition of the term in applying it to the accused Chevrolet Shifter in Findings 16 and 19 (R. 641):

Finding 16. "The composite linkage of Chevrolet includes three levers, all permanently attached together and secured to a shaft. (fol. 602.) The shaft is connected to the shifter elements. The lever group is connected to the hand lever, the valve, and the piston also. The connections are such that the hand lever is at all times connected to the shifter elements, and affords a continuous mechanical connection between the hand of the operator and the gear being shifted."

Finding 19. "An 'actuator' being something that actuates or puts into action or motion or incites to action, the composite linkage of the Chevrolet shifter is properly termed an 'actuator'." (R. 641.)

The District Court then ignored the "timed relationship" with which it defined the actuator in Finding 9.

The Circuit Court of Appeals similarly recognized these differences in structure (R. 692-693), but because of its re-

fusal to demand the structural precision required in combination claims, was able to apply them without restraint upon resemblances of function and effect. (R. 692-693.)

Respondent also entirely misses the point of the complaint as to the word "feel." While Respondent concedes that the patent does not mention this word and quotes the Circuit Court of Appeals at great length on the presence of "feel" in the respective structures involved, Respondent overlooks the fact that the Circuit Court of Appeals both said,

"The presence of the appreciation of 'feel' by Kesling is necessarily implied." (R. 682.)

and then found that because Kesling—

"uncovered this governing principle * * * he is entitled to a reasonably liberal range of protection." (R. 686.)

The Court then applied as a test of infringement, not the language of the claims, but the presence of this unidentified, functional phenomenon.

There is thus a substitution for the specific, structural terms which are necessary in a patent claim, an entirely new definition of the monopoly in terms merely of a function and effect not mentioned in the patent.

The File Wrapper Matter Is Not a Question of What the Circuit Court of Appeals Quoted From the File Wrapper But What Law Was Applied in Discarding These Vital Representations Made to the Patent Office.

Respondent dismisses the second question raised by the Petition for Writ of Certiorari on the effect of representations made to the Patent Office upon the interpretation of claims, by its statement that "The Court of Appeals quoted the language (from the file wrapper) in its opinion." (Resp. Br. p. 14.)

That is true. But immediately following this quotation from the file wrapper the Circuit Court of Appeals uttered an enlightening paragraph in which it expressly demonstrated that it was not looking to the claims or to the representations made to the Patent Office to interpret the patent, but was looking for a "conception" revealed by considering the state of the art, the implications of the patent specification to one skilled in the art, and only "limitations imposed and accepted during the progress of the application through the Patent Office."

"*Summary of Scope of Patent.* The scope of a patent is not a mathematical measurement. It is a *conception* reached by consideration of the combined effects of the state of the art, the contributions as revealed in the language of the patent to one skilled in the art, and any limitations imposed and accepted during the progress of the application through the Patent Office (*Smith v. Mid-Continent Inv. Co.*, 8 Cir., 106 F. (2d) 622, 624)." (R. 684.)

Thus the Court of Appeals quoted the language from the file wrapper and then immediately cited its own earlier opinion that these representations would not be considered in construing the patent claims, for in *Smith v. Mid-Continent Investment Co.*, that Court said:

"* * * We consider only the rejection and substitution of claims as the possible basis of estoppel." (106 F. (2d) 622, 627.)

It is not enough that the Circuit Court of Appeals quoted and then discarded the representations appearing in the file wrapper. The question raised by this Petition is whether or not the Circuit Court of Appeals' decision discarding these representations, in conflict with the decisions on this question in the First, Third, Sixth and Seventh Circuits, is the law.

Finally, it must be observed that in urging that the

Circuit Court of Appeals found "timed relationship" asserted for the Kesling structure in the accused Chevrolet shifter. Respondent cuts out its quotation from Record 692-694 between these revealing passages:

"The important consideration (in Chevrolet) is that the power does become effective before any pronounced movement of the gear shift elements. (R. 692.)

"Concisely, this method of operation is manual force admitting power force before any consequential movement of the gear shifting elements and, from there on throughout the entire normal gear shifting operation, *a unison of manual and power forces* with complete control in and mechanical connection with the hand of the driver—permitting 'feel'—*up to completion of the gear shift.*

* * * * *

"The difference between these two methods of operation has been aptly described by a witness for appellee. He states that the accused does the work of gear shifting 'by a division of forces'—*the hand and power acting together* to supply the united force—; while Kesling does this work by a 'division of portions of the shifter movement'—the hand doing the first part of the operation and the power doing the final part.

"It would seem that the accused device meets better the prime purpose of using power in shifting gears because it utilizes power to carry, *throughout the shift*, eighty per centum of the labor of shifting. On the other hand, Kesling uses no hand power in the final meshing while appellant uses twenty per centum of the force there employed. Even if accused may be the better structure, that is not decisive here." (R. 692-694.)

How can there be a "timed relationship" when there is "a unison of manual and power forces * * * up to completion of the gear shift," and the gear shifting is accomplished by "the hand and power acting together * * * throughout the shift"?

These passages eloquently establish that there is no timed relationship in Chevrolet. There the manual control and application of power "in unison" is continuous and indispensable. In Kesling there is manual control and manual application of force only until initial meshing of the gears and then complete lack of manual control or aid.

The Court of Appeals clearly discarded the vital representations made to the Patent Office to induce issuance of the patent, contenting itself with mere quotation of the language and re-affirming its view that such representations cannot affect the meaning of patent claims.

Conclusion.

There is no dispute that a conflict exists between the several Circuit Courts of Appeals as to an important question of patent law, whether representations made to the Patent Office to induce the issuance of a patent must be considered in the interpretation of the patent claims so procured.

In this case the Circuit Court of Appeals clearly discarded those representations as ineffective in construing the patent claims. The Court also ignored the requirements of combination claims prescribed in *Halliburton v. Walker*, 329 U. S. 1.

The effect of this decision is to permit a patentee to enforce a patent for mere functions and undisclosed functional effects, "feel", instead of confining him to structural claims of the precision which the statute dictates.

The Petition should be granted.

Respectfully submitted,

HORACE DAWSON,

CASPER W. OOMS,

Attorneys for Petitioner.

Chicago, Illinois,
February 20, 1948.

FILE COPY

U.S. Supreme Court, U.L.
FILED
FEB 18 1948

CHARLES ELMORE ROGERS
CLERK

IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1947.

No. 558.

GENERAL MOTORS CORPORATION,
Petitioner,

v.

ELMER G. KESLING,
Respondent.

**BRIEF IN OPPOSITION TO PETITION
FOR A WRIT OF CERTIORARI.**

EDMUND C. ROGERS,
ESTILL E. EZELL,
Attorneys for Respondent.

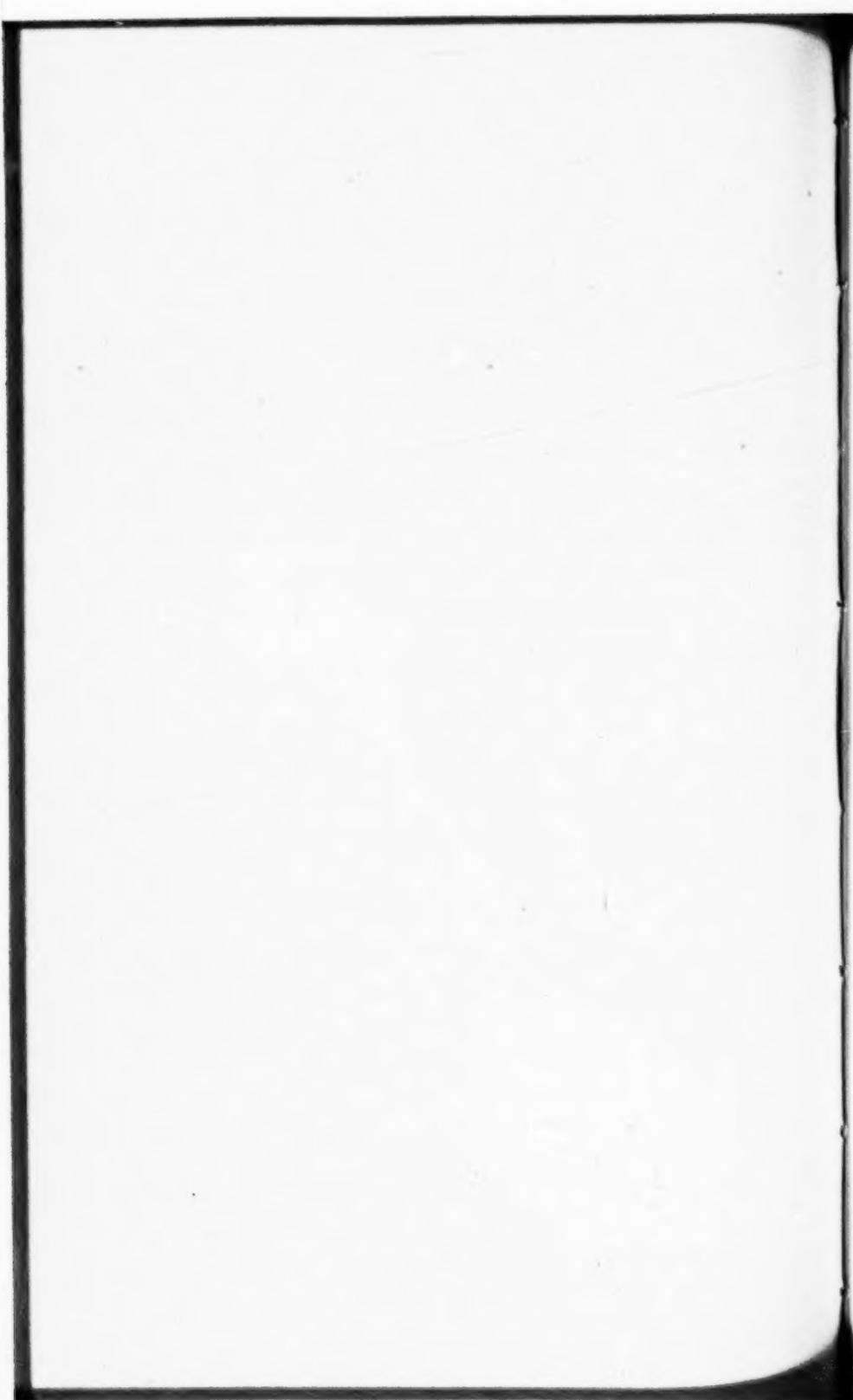
(

INDEX.

	Page
Summary of argument.....	1
Argument	3
(1) The Kesling claims are for clearly defined combinations	3
(2) The file wrapper matter.....	14
Conclusion	16

Case Cited.

Halliburton Oil Well Cementing Co. v. Walker, 329 U. S. 1	13, 16
--	--------



IN THE
SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1947.

No. 558.

GENERAL MOTORS CORPORATION,
Petitioner,
v.
ELMER G. KESLING,
Respondent.

**BRIEF IN OPPOSITION TO PETITION
FOR A WRIT OF CERTIORARI.**

SUMMARY OF ARGUMENT.

The Courts below have already specifically held against petitioner on every matter raised in the petition. The Court of Appeals, in an opinion by Judge Stone, concurred in by Judges Thomas and Johnsen (R. 671, 164 F. [2d] 824), unanimously affirmed the judgment of the District Court, which Court had filed findings of fact and conclusions of law (R. 635, 66 F. Supp. 1).

Petitioner alleges that there are two "questions presented" by its petition. Both are fully answered by the facts found below:

(1) The claims were found by both Courts below to recite no mere catalogue of elements, but rather a combination of elements, consisting of a handle, a power operating means, a valve, and shifter elements, with an actuator disposed centrally of the operating group and having connections radiating out to all of them. Both Courts below have found that the actuator is a composite device well illustrated by the patent, and having its counterpart in the Chevrolet shifter.

(2) Both Courts below did, as a matter of fact, consider the representations made in the file wrapper; and the Court of Appeals even QUOTED THE VERY LANGUAGE PETITIONER SAYS IT REFUSED TO CONSIDER.

ARGUMENT.

(1) The Kesling Claims Are for Clearly Defined Combinations.

Petitioner contends that the Kesling claims do not define the structure, mode and operation of the parts in combination. The exact contrary was found by the Courts below, which found that the claims define precise interconnections between the handle, the actuator, the shifter element, the piston, and the valve. The Courts below said that the parts are grouped around the actuator, and each part has its connection extending inwardly to the actuator. Finding of Fact 9 (R. 638), by the District Court, states:

“Kesling, for the first time introduced a power shifter for sliding gears wherein the hand participated with the power in effecting the shifting. He embodies this in a mechanism having a hand lever, a vacuum power device, valve mechanism to control the power device, and shifter elements. All of the foregoing were known in the art. But Kesling combined these mechanisms through a composite central mechanism or actuator *from which all of the four operating elements radiated and with which they were all connected.* This actuator was a composite of members arranged to cause the hand lever and the power device to operate in a timed relationship. In the prior art, the power always led the hand so that there was only a power-produced gear movement at the critical point of mesh. In Kesling, this composite actuator assured that there would be manual domination through the first part of the shift which, in the terms of the art, means up through the point of mesh.”
(Emphasis added.)

This finding of fact makes abundantly clear that the actuator is disposed at the center of the group of elements, and that the other component elements "radiated" from it. It is in this physical sense only, and in no figurative or legal sense, that the Kesling actuator is at the heart of the combination.

The District Court, in Findings 9 and 11, described the Kesling combination and the illustration in the Kesling patent. Then that Court referred to the claims as follows, in Finding 13 (R. 640) :

"The foregoing illustration in the Kesling patent furnishes a basis for Kesling's claims of a novel combination of elements. This combination consists essentially of a hand operating means, a power operating means, a valve control, and shifter elements, all connected to a composite central *actuator* disposed centrally of the operating group. This combination, regardless of the details of the individual elements, marks a clear departure made by Kesling over the prior art."

It is evident that the District Court found the Kesling claimed combination to be more than merely an actuator, and more than merely a catalogue of several elements of which the actuator is one. The District Court found, flatly contrary to petitioner's present contention, that the Kesling claims were directed to a combination of elements, *all interconnected* in a very definite way.

Not only did the District Court find against petitioner on its contention that the Kesling claims are mere catalogues of elements, without any connections or interrelations, but also the Court of Appeals did likewise.

The Court of Appeals quoted the language of the claims in suit (R. 678-9). In contradiction to petitioner's argu-

ment that the claims merely catalogue elements without indicating their interconnections or operation in combination, the Court of Appeals said (R. 679) :

“ * * * Each of these claims states the physical combination of the various mechanical elements and their functional interrelationship and operation.

“ Analysis of any of these claims reveals a *combination mechanical structure* composed of gear shift elements, manually operated elements, power operated elements and an ‘actuator.’ The heart of the combination is the actuator. To it, the shift, the manual and the power elements are *all mechanically connected*. The tie in of the power element is with two parts thereof—the control valve and the piston—with the results that movement of the actuator opens the valve bringing in the power and this power, through movement of the piston, in turn is exerted upon the actuator. Necessarily, manual force must be used to move or to set in motion the actuator to the point where the actuator opens the valve. * * * ” (Emphasis added.)

The remainder of these paragraphs is valuable to show how thoroughly the Court of Appeals investigated the precise issue raised by petitioner, and found against petitioner.

The Court of Appeals, discussing claim language, also said (R. 685) :

“ As to the language of the patent. Each of these five Claims covers an ‘actuator’ to which are *mechanically connected* manual means of moving the actuator; power means to be released by movement of the actuator and which, when released, operates to move the actuator; and gear shifting means moved by the actuator. The starting force which moves

the actuator to the stage when the valve is opened, bringing the power into activity, is manual." (Emphasis added.)

The subsequent paragraphs on the same subject matter might also be quoted here, but for unnecessarily lengthening this brief. The quotations given show quite clearly that the Courts below considered the point petitioner now makes and held that the Kesling claims were not merely catalogues of elements, but were definitions of structure wherein the components were interconnected in particular ways, for particular purposes.

The Courts below ruled upon the alleged issue of identity of the actuator. In Finding of Fact 9 (R. 638), the District Court found:

"* * * He (Kesling) embodied this is in a mechanism having a hand lever, a vacuum power device, valve mechanism to control the power device, and shifter elements. All of the foregoing were known in the art. But Kesling combined these mechanisms through a composite central mechanism or actuator from which all of the four operating elements radiated and with which they were all connected. This actuator was a composite of members arranged to cause the hand lever and the power device to operate in a timed relationship. In the prior art, the power always led the hand so that there was only a power-produced gear movement at the critical point of mesh. In Kesling, this composite actuator assured that there would be manual domination through the first part of the shift which, in the terms of the art, means up through the point of mesh."

In Finding 11 (R. 639), the District Court found:

"The Kesling patent illustrates one embodiment of the Kesling invention, wherein the hand lever, the

valve, the power device, and the shifter elements all are grouped about a composite actuator having connections with all of them. In the illustration, the actuator comprises a shaft that is geared to the hand lever shaft, is geared to the power piston, is cammed to the valve mechanism, and is geared to the shifter elements. The arrangement is such that the hand starts a shifting operation by initiating movement of the actuator (as distinguished from the prior art wherein the hand initiates movement of the valve alone). The actuator is connected with the shifter elements so that this initial movement of the actuator results in the application of a manual shifting force to the gears. In due course, this movement of the actuator, through the connection of the actuator and the valve by the cam arrangement, opens the valve to admit power to assist in the shifting operation. This power is fully introduced in the latter part of the shifting operation—i. e., after point of mesh—so that there is no domination by power of the hand at the critical point.”

While infringement is not one of the primary questions specifically presented by the petition, we note that along with detailed findings of identity of structure, result, and function, between Chevrolet and Kesling, the District Court found (Findings 18, 19, R. 641):

18.

“Chevrolet adopted the principle shown by Kesling, that the hand must do part of the job of shifting in order to have a practical power shifting means. Chevrolet embodied this principle, in the novel combination disclosed by Kesling, of a composite actuator centrally disposed of and *connected* to the hand lever, the valve, the power piston, and the shifter elements.” (Emphasis added.)

19.

"An 'actuator' being something that actuates or puts into action or motion or incites to action, the composite linkage of the Chevrolet shifter is properly termed an 'actuator.' "

The Court of Appeals specifically ruled upon the identity of the actuator. Previously quoted sections of the opinion, such as Record page 679 and page 685, show this. And see also (R. 688) :

"In Kesling, hand means are connected to a crank shaft or spindle which is connected to the gear shift means, the power valve control means and the power means piston. It is this spindle with its connections to the gear shift, the valve and the piston which make up the actuator. * * *"

And page 689:

"What Kesling taught broadly was that this hand control at the critical shifting point and use of power force in the shifting operation could be accomplished by harnessing hand force, power force and shifting elements together through a focal unit which would produce these desired uses of power and hand control and which he calls an 'actuator.' His preferred form showed such construction."

And, speaking of the Chevrolet shifter, the Court of Appeals said (R. 690) :

"* * * This composite interlinkage of these three 'levers' was found by the trial court to be an actuator. This finding is sound."

The sophistry of petitioner's argument that the actuator is not identifiable is shown by the fact that petitioner itself identified the actuator from its first reading of the Kesling

patent. Before the trial was ever begun, petitioner prepared its own Defendant's Exhibit S, all without aid from anyone. At the trial, petitioner offered this exhibit in evidence. The exhibit is a colored drawing of the Kesling structure, whereon petitioner itself had carefully painted, what it already knew to be the actuator, a brilliant red (R. 541).

Everyone who has been involved in this case has identified the actuator with no trouble. This includes the parties and the four judges of the two courts—not to mention the Patent Office. Petitioner is simply in no position to make an argument at this late stage that it cannot identify the actuator. Its own actions speak too loudly.

Petitioner argues that the word "feel" is not mentioned in the Kesling patent. This is true, but, as both Courts have already specifically ruled, "feel" is merely a word of convenient summary of a longer explanation in the Kesling patent itself. The District Court Finding of Fact 21 is:

"Kesling discloses the central composite actuator in combination with the four actuating elements of this combination wherein the hand controls the first part of the shift. The evidence supports the fact that to the transmission art, the division of a gear engaging operation is at point of mesh. Kesling clearly introduced into the art the manual control of the shift at this point. No shift of the prior art without this feature apparently was mechanically successful. And in this respect Kesling discloses that 'feel' would be present at the point of synchronization."

Also, in Finding 11, the District Court described the structure and operation of the patented shifter in detail, and then found (R. 639, 640):

"The construction affords a continuous mechanical connection between the hand of the operator and the gears being shifted. By this, the operator may feel the gears into mesh. By the connection of the hand lever, as well as the power piston and valve to the actuator, the hand may control the shift at point of mesh and prevent a forced engagement of the gears."

Petitioner's argument was also made to the Court of Appeals, who answered it in detail (R. 681-2), devoting a whole section of the opinion to "Feel." Petitioner, quite inexcusably we think, mentions the statement of the Court that the patent does not contain the word "feel," without even suggesting that the opinion explained at great length that the longer explanation of the patent means the same thing. The opinion (R. 682) holds:

"(1) The patent nowhere contains the word 'feel.' However, the teaching of the patent clearly reveals such when it is read by one skilled in the art. One so skilled would know the problem Kesling was trying to solve. Briefly, that problem was to overcome the defect in all prior attempts to apply power to this style of shift. Prior attempts had been to employ power throughout to do the entire work of shifting. The defect in such method was the insensibility of power to this critical point in the shift when the gears come into initial contact. The skilled person would know that the main reason for Kesling keeping sufficient hand control at this critical point would be to remedy this defect. The skilled person would know the remedy would be ineffective without this 'feel.' For Kesling to express in the patent this matter of 'feel' would be stating what anyone skilled in the art would know already. The presence of the appreciation of 'feel' by Kesling is necessarily implied. This impli-

cation is emphasized by the language of the Specifications describing the operation of the preferred structure and by the language of most of the Claims which bring in the power after the 'initial' gear movement or at the 'final' movement."

No one has ever contended that Kesling was the first to provide feel in a sliding gear transmission. Feel was inherent in all manual shifters. Kesling was the first to provide a power shifter having a mechanism that would retain this feel and yet provide power for the shifting operation.

Respondent assumed the burden of proving that the accused Chevrolet shifter and the Kesling shifter operated in substantially the same way, to attain the same result, by substantially the same means. The District Court found in detail as to the structure and operation of both the Kesling and the Chevrolet shifter, which findings establish their identity. Finding 23 is only a summary of the previous findings, but it clearly shows that the trial Court found identity of result, identity of means, identity of interoperation of means between the patented and the accused device. This Finding 23 is (R. 642):

"The present claims are not limited by the art beyond the obvious meaning of their words. At this level, it is clear that the Chevrolet structure attains the same result—a power-aided shift of sliding gears—by substantially the same means—a composite actuator centrally disposed with respect to the manual means, the power piston, the valve, and the shifter element—the means cooperating in the same way—by providing a continuous manual (mechanical) connection between the hand of the operator and the gear, as well as the valve, so that manual feel and manual control at point of mesh may be had."

The Court of Appeals opinion states (R. 687):

"The parties agree that to constitute infringement the accused device must, in a patent sense, accomplish the same result and by the same means and by the same method of operation (citations). There is agreement that, if any one of these requirements is lacking there is no infringement (citations). Appellant contends that its device does not produce the same result nor by the same means nor by the same method of operation."

Thereafter the Court of Appeals devotes separate sections of its opinion to "Result," "Means," and "Method of Operation," finding identity between the accused and patented device, as to all three. At page 690, the Court of Appeals said:

"Kesling's actuator consists of a hand moved spindle or shaft connected by cams and gears with the valve, the piston and the shift gears in such manner as to produce cooperative action resulting in retaining hand 'feel' and control past the critical shifting point. Appellant's actuator consists of a shaft connected to links and levers and producing the same desirable results. Cams and gears and links and levers, as well as their functions and operations, are old in mechanics and, within the scope of this patent, are equivalents known to skilled mechanics. The finding of the trial court to this effect is sustained."

Clearly both Courts below have already treated the matter of infringement from the most strictly proper legal basis, so that petitioner's argument here is but a reargument. Certainly petitioner's argument that the Chevrolet shifter is wholly unlike Kesling's shifter in structure, function, or result is in direct opposition to the exact fact findings of both lower Courts.

It should be evident that the present patent and its claims are entirely distinct from those in *Halliburton Oil Well Cementing Co. v. Walker*, 329 U. S. 1. The claims in suit specify a combination of elements, all having definite interconnection. As both Courts below have held, Kesling did not claim novelty in the bare catalogue of elements, but only in those elements interconnected in a particular way. Kesling did not attempt to predicate novelty merely on the addition of an "actuator" to old elements. Nor do the claims at issue rely upon a "means" clause that employs conveniently functional language at the point of novelty. They recite identifiable mechanical components. The physical structure of the actuator, and the interrelation of the several parts, including the actuator, to each other, and the manner in which the parts interoperate, are all clearly set forth in the claims, in terms unmistakable and unmistaken.

Kesling cannot stop use by others of the "catalogue" of elements of his claims, *except when others also provide* the specific interconnections required by the claims. All of the claims are for particular components, particularly interconnected. Anyone who can obtain the same result by the same elements differently connected is free of the patent. And anyone who can obtain the same result by different elements, regardless of interconnections, is free of the patent.

The Kesling claims are of the type approved by this Court in the *Halliburton* case, because they "structurally described the physical and operating relationship of all the crucial parts of the novel combination." As both Courts below have already held, and as is obvious from a reading of the claims in suit, those claims insist upon certain physical components, all interconnected in a particular way, so that, as the Court of Appeals said, the ac-

tuator is located at the heart of the group of elements, with connections to each radiating outwardly from the actuator to such element.

(2) **The File Wrapper Matter.**

Petitioner contends that the Courts below, contrary to decisions of this and other Courts, refused to consider statements of argument presented by Kesling to obtain allowance of his claims.

The answer to this quite false contention is that both Courts below did consider the very file wrapper statements upon which petitioner relies.

Petitioner's contention is astonishing. Respondent quoted the statements in question in his District Court brief and discussed them. Petitioner quoted and discussed them in its trial Court brief. Petitioner quoted the language and discussed it in its Appellate Court brief. Respondent did likewise. The Court of Appeals quoted the language in its opinion (R. 683-4).

In the face of the utter impossibility for either lower Court to have refused to consider language so thoroughly presented to them, and argued before them, petitioner's point is a creation out of thin air.

Of course, the answer is that the language in the file wrapper does not have the meaning petitioner attributes to it. Respondent quoted it because, in our opinion, it indicates a distinction over the art found in *both* Kesling and Chevrolet. Both Courts agreed that, as a matter of fact, it does just that (cf. R. 686-7). The "timed relationship" is present in both. Petitioner contends that Chevrolet has no such timed relationship. There were demonstrations in the trial Court proving it to be true.

In at least one lower Court brief, petitioner admitted it. And the Court of Appeals certainly found the timed relationship in the Chevrolet shifter. Note, for example, the timing of the manual and power movements discussed in the following portion of the opinion below (R. 692) :

"The method of operation of the accused device is as follows. Manual force initiates and continues throughout the entire shift operation. This manual force is first communicated to the valve lever which starts opening the valve port; continued manual pressure on the valve lever takes up any 'lost motion' clearance in the linkage between the valve lever and the reaction lever then causing movement of the reaction lever; still continued manual pressure takes up any 'lost motion' clearance in the linkage of the shifter lever then causing the shifter lever to start moving the gear shift elements; power force comes into exertion (through the piston rod connection to the reaction lever) upon the reaction lever and, through linkage, upon the shifter lever at least as early as the beginning of movement of the shifter lever; the combined manual and power force continue the shifting movement to completion or until halted by withdrawal of manual force. The manual force is necessary not only to initiate the entire shifting operation but also continuously until the operation is completed. * * *"

The remainder of this section of the opinion brings out the same timed relationship.

There is no real issue on the file history language. It was specifically considered below.

CONCLUSION.

Petitioner has raised two entirely false and non-existent questions.

The first question created by petitioner is that the claims are indefinite in the *Halliburton* sense. This is quite untrue, as the consistent rulings of the Courts below have held. Petitioner's repetition of such expressions as "sweeping generality of the term 'actuator,'" and "promiscuity" of the term, and "term of such versatility" and "verbal hocus pocus," is not based upon any deficiencies in the Kesling claims or in the opinions below. It is, we suppose, catch phraseology designed to give the impression that the Courts below have done violence to established principles, in deciding the case for respondent.

But there is not the slightest evidence in support of this freely used catch phraseology. For Kesling's claims, as is evident from their language, and from the findings of the District Court, and from the opinion of the Court of Appeals, all require full combinations of fully interconnected elements that attain new results. They are not claims to merely an actuator; they are claims that require specifically that the actuator have connections of delineated type with each of four other elements of the claim, all for indicated purposes. And they are infringed only by a shifter that has these same components similarly interconnected, for the same purpose. On this basis, both Courts below held that the Chevrolet shifter infringes.

There is no truth to petitioner's alleged "question" that the Court of Appeals refused to consider language of the file history. The Court actually quoted (R. 683) the very language in question, in its opinion, and discussed its meaning (R. 686).

In closing, may we say that the findings of the trial court and the opinion of the Court of Appeals (R. 637, 677, 685) are that the prior art had sought a power shifter for over twenty years. Numerous efforts all resulted in failure. Only when Kesling described the principle of manual domination of power at point of mesh, and that mechanical connection that affords what, for simplicity, we call "feel," and only when Kesling illustrated a mechanism that would embody that principle, was there ever a commercially successful power shifter.

Even Bendix and General Motors had tried, and met failure. Bendix tried Moorhouse and met failure. Then Bendix, after having seen the Kesling disclosure with its novel arrangement, employed the Kesling combination, with its components and connections, and sold over 2,500,000 units (R. 690, referring to R. 297, 554).

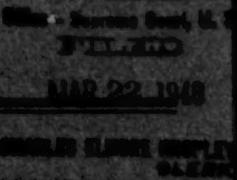
It is submitted that there is justification for the decisions below, and that there are no real issues presented by the petition. We suggest that to delay the matter further for mere reargument of old fact issues is to require of respondent more delay and expense than should be required of him.

Respectfully,

EDMUND C. ROGERS,
ESTILL E. EZELL,
Attorneys for Respondent.

St. Louis, Missouri,
February 16, 1948.

FILE COPY



IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1947.

No. 558

GENERAL MOTORS CORPORATION,

Petitioner,

vs.

ELMER G. KESLING,

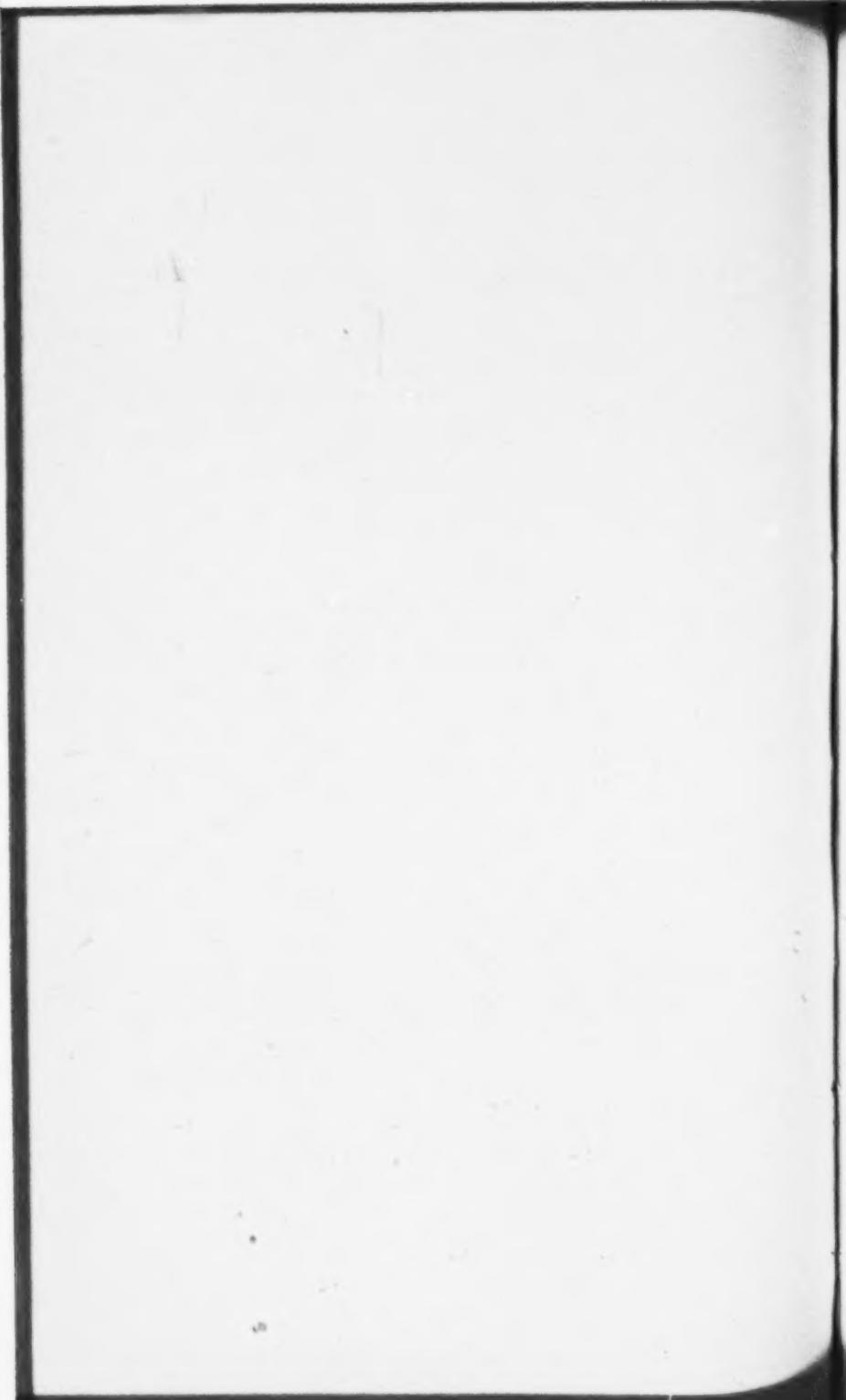
Respondent.

**PETITION FOR REHEARING OF PETITION FOR A
WRIT OF CERTIORARI TO THE UNITED STATES
CIRCUIT COURT OF APPEALS FOR THE EIGHTH
CIRCUIT AND BRIEF IN SUPPORT THEREOF.**

HORACE DAWSON,
CASPER W. COOK,
209 S. LaSalle Street,
Chicago, Illinois,

Attorneys for Petitioner.

EDWIN S. BOOTH,
JOSEPH J. GRAVELY,
Of Counsel.



J

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1947.

No. 558

GENERAL MOTORS CORPORATION,

Petitioner,

vs.

ELMER G. KESLING,

Respondent.

PETITION FOR REHEARING OF PETITION FOR A WRIT OF CERTIORARI.

*To the Honorable, the Chief Justice and Associate Justices
of the Supreme Court of the United States:*

Your Petitioner, General Motors Corporation, respectfully prays for rehearing of the Petition for a Writ of Certiorari heretofore filed herein, and under Rule 33 of this Court as amended October 13, 1947, shows as grounds thereof not previously presented:

1. The Eighth Circuit Court of Appeals has in this case laid down a test for the construction of a patent that violates the statute (Title 35, U. S. Code, Sec. 33), saying:

"Broad as is the language of these claims, their scope depends upon the discovery revealed in the explanatory Specifications." (R. 680)

* * *

"(1). The patent nowhere contains the word 'feel.' (R. 682)

* * *

"Summary of Scope of Patent. The scope of a patent is not a mathematical measurement. It is a conception reached by consideration of the combined effects of the state of the art, the contributions as revealed in the language of the patent to one skilled in the art, and any limitations imposed and accepted during the progress of the application through the Patent Office (*Smith v. Mid-Continent Inv. Co.*, 8 Cir., 106 F. (2d) 622, 624). (R. 684)

* * *

"While he cannot claim all manner of construction which will apply this principle of hand feel and control because of his own expressed limitations of 'objects,' on the other hand, because he uncovered this governing principle of the way to solve the problem of utilizing power in such gear shifts and has shown the way he thought to be the best solution, he is entitled to a reasonably liberal range of protection." (R. 686)

2. The Patent Act requires and this Court has repeatedly held, "The scope of every patent is limited to the claims contained in it, read in the light of the specification."

Motion Picture Patents Co. v. Universal Film Mfg. Co., 243 U. S. 502, 510.

and * * * "the precise terms of the grant define the limits of a patentee's monopoly" * * * and "patent grants are to be construed strictly," * * *

United States v. Line Material Co., U. S.; 76 U. S. P. Q. 399, 405, 407, (decided March 8, 1948).

In *Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U. S. 477, 487, this Court said:

"(3-4) The Court of Appeals, in upholding the patent, made no examination of its separate claims, but treated the patent throughout as though it were a combination of five distinct elements, the photo-electric cell, the arcuate flexing of the film, the fly-wheel, and the optical slit, although nowhere in the patent is any such combination claimed. The patent thus upheld is one which was neither claimed nor granted. *Under the statute, it is the claims of the patent which define the invention.* And each claim must stand or fall, as itself sufficiently defining invention, independently of the others." (Emphasis added).

In *Universal Oil Prod. Co. v. Globe*, 322 U. S. 471, 484-485, this Court said:

"The claim is the measure of the grant. * * * The claim is required to be specific for the very purpose of protecting the public against extension of the scope of the patent."

3. Practically every Circuit Court of Appeals has similarly held that "The monopoly of a patent is limited in its scope to the claims thereof."

Braun v. John Griffiths & Son Co., 234 F. 636, 639 (C.C.A. 7).

"Claims can be no broader than the invention as disclosed."

Baker Perkins Co. v. Thomas Roulston, Inc., 62 F. (2d) 509, 513, (C.C.A. 2).

H. Schindler & Co. v. Saladino & Sons, 81 F. 649, 654 (C.C.A. 1).

"However meritorious an invention may be, and however much it may contribute to the development of the art or science to which it re-

lates, the protection afforded by a patent thereon is confined to its disclosures."

Price-Trawick, Inc. v. Gas Lift Corp., 101 F. (2d) 134, 136-137 (C.C.A. 5).

"The monopoly granted to the inventor is defined by the claims of his patent."

Metal Cutting Tool Service v. National Tool Co., 103 F. (2d) 581, 584 (C.C.A. 6).

"It is thoroughly well established that the patentee is limited to his claims, and the patent is no broader than the claims, and, if the language of claims of the patent is clear and distinct, the patentee is bound by the language he has employed."

Wilson & Willard Mfg. Co. v. Union Tool Co., 249 Fed. 729, 734 (C.C.A. 9).

4. The conflicting opinion and decision of the Circuit Court of Appeals in this case applies a principle of great importance in the administration of the patent law, and substitutes for the statutory patent document an undefinable area of monopoly, a "conception" which no man could measure.

5. The growing economic embrace of a patent demands that its grasp be expressly defined and that its terms be not distended by vague considerations foreign to the grant itself.

In this case, as is evident from the brief fragments* of the opinion of the Court of Appeals quoted above, that Court gave the claims of the patent in suit a "scope" not measured by the claims but expanded to an immeasurable, but liberal, content because the Court ascribed to the patentee the discovery of a principle not mentioned in the patent.

* A more extended statement of the facts appears in the Petition for the Writ of Certiorari and is not repeated here.

If patents are to be accorded these hidden, unexpressed values, their limits varied with the accordion-like "conception" that may thus be contrived, they will become monopolies never contemplated by law, never granted, and never detected by those who would sincerely avoid trespassing upon them.

Wherefore Petitioner prays that a rehearing be granted of its Petition for a Writ of Certiorari, and that Writ issue.

Respectfully submitted,

HORACE DAWSON,

CASPER W. OOMS,

Attorneys for Petitioner.

Chicago, Illinois,

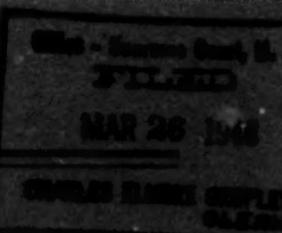
March 22, 1948.

Certificate of Counsel.

I hereby certify that this Petition for Rehearing is presented in good faith and not for delay and is restricted to the grounds above specified.

Attorney for Petitioner.

FILE COPY



**IN THE
SUPREME COURT OF THE UNITED STATES.**

OCTOBER TERM, 1947.

No. 558.

**GENERAL MOTORS CORPORATION,
Petitioner,**

v.

**ELMER G. KESLING,
Respondent.**

**RESPONDENT'S BRIEF OPPOSING REHEARING
AFTER DENIAL OF PETITION FOR
CERTIORARI.**

**EDMUND C. ROGERS,
ESTILL E. EZELL,
Attorneys for Respondent.**



IN THE
SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1947.

No. 558.

GENERAL MOTORS CORPORATION,
Petitioner,

v.

ELMER G. KESLING,
Respondent.

**RESPONDENT'S BRIEF OPPOSING REHEARING
AFTER DENIAL OF PETITION FOR
CERTIORARI.**

There is nothing new in the Petition for Rehearing. Certainly there are no "other substantial grounds available to petitioner although not previously presented" in the sense of Rule 33 as amended. Everything in this petition appeared in the original petition. Respondent inevitably inquires how many petitions are required for petitioner to present its full argument to this Court.

The argument of the Petition for Rehearing is the same erroneous argument about "feel", containing the same, wrong contention that the Court of Appeals awarded Kesling a patent on every shifter having "feel". To

the contrary, Kesling never claimed to have invented "feel", and the Court of Appeals referred to the matter of "feel" as "what anyone skilled in the art would know already" (R. 682). Obviously, the Court did not give Kesling a patent on something of common knowledge.

What Kesling patented was, as the Court of Appeals said (R. 679): "* * * the physical combination of the various mechanical elements and their functional interrelationship and operation." And continuing, the Court said that analysis of each claim "reveals a combination mechanical structure."

Infringement of these claims of "mechanical structure" was held because, as all of the judges below unanimously agreed, the Chevrolet shifter employed structure to "accomplish the same result and by the same means and by the same method of operation" (R. 687).

It is submitted that there is no basis for the Petition for Rehearing. No argument is offered that was not made in the original petition. The words are different but the syllogism is the same.

There is no merit in the arguments. Their premises torture the language of the Court of Appeals. Their fallacies do violence to logic and reason.

It is, therefore, urged that the Petition for Rehearing be denied, and that this lawsuit be brought to a final close at long last.

Respectfully,

EDMUND C. ROGERS,
ESTILL E. EZELL,

Attorneys for Respondent.

St. Louis, Missouri,
March 24, 1948.